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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,098	11/21/2003	Terrence A. Tomkow	RPOST-66231	1930
24201 7590 04/08/2009 FULWIDER PATTON LLP HOWARD HUGHES CENTER 6060 CENTER DRIVE, TENTH FLOOR LOS ANGELES, CA 90045				
EXAMINER				
GELAGAY, SHEWAYE				
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2437				
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04/08/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/719,098

Applicant(s)

TOMKOW, TERRENCE A.

Examiner

SHEWAYE GELAGAY

Art Unit

2437

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 7, 9-11, 13, 14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 9-11, 13, 14 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the Applicant's amendment filed on January 12, 2009. Claims 1-2, 5, 9, 11 and 14 have been amended. Claims 5, 8, 12 and 15 have been cancelled. Claims 1-4, 6-7, 9-11, 13-14 and 16-20 are pending.

Response to Arguments

2. Applicant's arguments filed January 12, 2009 have been fully considered but they are not persuasive. In response to the applicant's arguments the following comments are made:

3. The applicant argued that "claim 1 was amended to recite generating a manually initiated reply to a message at a recipient, the manually initiated reply including a request from the recipient to receive proof of transmission or delivery of the manually initiated reply to the sender, and also that the server transmits the manually initiated reply to the sender in a manner wherein the server receives an indication that the reply is transmitted or delivered to the sender and then transmits the indication that the reply is transmitted or delivered to the sender to the recipient." (see 35 USC 112 below)

The applicant argued that "Tomkow discloses only receiving Delivery Status Notification (DSNs) that are returned to the server by the Mail Transfer Agent (MTA) or Mail User Agent (MUA) of the recipient. Those skilled in the art know that DSNs are automatically generated by a recipient's email system if the system provides for their support." Applicant disclosure on paragraph 341 describes "the term recipient is also

intended in the claims to include any agent of the receiver with respect to the message and attachment. Such agent may include a Mail Transfer Agent of the recipient.”

Therefore the recipient in the instant application includes any agent of the receiver. As applicant admitted in the response filed 1/12/09, Tomkow discloses receiving Delivery Status Notification that are returned to the server by the Mail Transfer Agent. (page 10, lines 11-15; page 13, lines 20-21)

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “manually uninitiated reply by the server to the sender” “wherein the sender does not have to include instructions to obtain a return receipt”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant argued that “Tomkow teaches a read receipt which is passed through the server by changing the header information. ...A read receipt is an email sent to the author of a message by the recipient's MUA or MTA when certain events occur and is consequently system generated. A reply is a new message initiated by the manual actions of a recipient and sent to the original sender by the recipient. Furthermore, a read receipt, unlike a reply, does not include instructions to the server to obtain proof of transmission, delivery or content of the reply that is transmitted to the sender and, when such information is received by the server, sent to the recipient of the original message. A read receipt provides only that the original message from the

sender was received by the recipient's email system. Therefore, a read receipt cannot be a reply in the sense that term is used in amended claim 1, and all other claim in the application." The examiner respectfully disagrees. The specification on paragraph [334-340] describes "the recipient composes a reply and sends it to the fictitious address. The message arrives at the RPost server. On receiving the message, the RPost server parses the destination address of the reply to extract the message and destination ID. The server queries the database to recover the true address of the original sender of the message. The server readdresses the message to the original sender. The message is sent in a manner which allows the system to record proof of delivery and proof of content ... This may be provided by generating copies of a delivery receipt. The delivery receipts are then made available to both the sender of the original message and to the recipient." Consistent with the applicant's teaching, Tomkow discloses to insure that recipient replies to transmitted messages are directed properly system will add an explicitly "reply-to" message header into the message listing the original sender's name and Internet address. This will lead recipient MUAs to address replies (i.e. reply not receipt) to a received message to the actual sender's address, rather than the constructed RPost address. (page 16, line 31-page 17, line 5)

4. The rest of Applicant's arguments have been considered but are moot in view of new grounds of rejection.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 9, 11 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 9, 11 and 14 recite "generating a manually initiated reply to the message at the recipient," that is not disclosed in the application as filed. The applicant in the original specification at the time of the filing has not described the claimed limitation. The examiner requests the applicant to provide the exact paragraph in the specification that supports the amendment "generating a manually initiated reply to the message at the recipient."
7. Claims 1, 9, 11 and 14 recite "the manually initiated reply including a request from the recipient to receive proof of transmission or delivery of the manually initiated reply to the sender" that is not disclosed in the application as filed. The applicant in the original specification at the time of the filing has not described the claimed limitation. The examiner requests the applicant to provide the exact paragraph in the specification that supports the amendment "the manually initiated reply including a request from the recipient to receive proof of transmission or delivery of the manually initiated reply to the sender."
8. Claims 1, 9, 11 and 14 recite "processing the request by the recipient to receive proof of transmission or delivery of the manually initiated reply to the sender" that is not

disclosed in the application as filed. The applicant in the original specification at the time of the filing has not described the claimed limitation. The examiner requests the applicant to provide the exact paragraph in the specification that supports the amendment "the manually initiated reply including a request from the recipient to receive proof of transmission or delivery of the manually initiated reply to the sender."

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-4, 6-7, 9-11, 13-14 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomkow WIPO Publication WO 01/10090 in view of Jevans WO 00/25245.

As per claims 1, 9, 11 and 14:

Tomkow teaches a method of providing a receipt of an email with proof of transmission, receipt and content of a reply to the email that is manually initiated by the recipient, comprising:

receiving a message from a sender at a server displaced from the recipient;
(page 4, line 6-11; page 10, line 5-page 11, line 14; page 20, line 10-page 21, line 6;
page 31, line 24-page 32, line 6)

assigning a unique identification of the message by the server; (page 4, line 6-11; page 10, line 5-page 11, line 14; page 20, line 10-page 21, line 6; page 31, line 24-page 32, line 6)

storing the unique identification of the message in a database; (page 4, line 6-11; page 10, line 5-page 11, line 14; page 20, line 10-page 21, line 6; page 31, line 24-page 32, line 6)

transmitting the message from the server to the recipient; (page 4, line 6-11; page 10, line 5-page 11, line 14; page 20, line 10-page 21, line 6; page 31, line 24-page 32, line 6)

generating a manually initiated reply to the message at the recipient; (page 4, line 6-11; page 10, line 5-page 11, line 14; page 16, line 31-page 17, line 5; page 20, line 10-page 21, line 6; page 31, line 24-page 32, line 6)

transmitting the manually initiated reply to the sender through the server; (page 4, line 6-11; page 10, line 5-page 11, line 14; page 20, line 10-page 21, line 6; page 31, line 24-page 32, line 6)

receiving the manually initiated reply at the server; (page 4, line 6-11; page 10, line 5-page 11, line 14; page 20, line 10-page 21, line 6; page 31, line 24-page 32, line 6)

processing the request by the recipient to receive proof of transmission or delivery of the manually initiated reply to the sender; (page 4, line 6-11; page 10, line 5-page 11, line 14; page 20, line 10-page 21, line 6; page 31, line 24-page 32, line 6)

transmitting the manually initiated reply by the recipient to the sender in a manner wherein the server receives an indication that the reply is transmitted or delivered to the sender; (page 4, line 6-11; page 10, line 5-page 11, line 14; page 20, line 10-page 21, line 6; page 31, line 24-page 32, line 6) and,

transmitting the indication that the reply is transmitted or delivered to the sender to the recipient. (page 4, line 6-11; page 10, line 5-page 11, line 14; page 20, line 10-page 21, line 6; page 31, line 24-page 32, line 6)

Tomkow does not explicitly disclose a manually initiated reply including a request from the recipient to receive proof of transmission or delivery of the manually initiated reply to the sender. Jevans in analogous art, however, discloses a manually initiated reply including a request from the recipient to receive proof of transmission or delivery of the manually initiated reply to the sender. (page 27, line 8-page 28, line 29) Therefore it would have been obvious to one ordinary skill in the art at the time the invention was made to modify the method disclosed by Tomkow with Jevans in order conduct and audit electronic transactions that allows users to accept or reject received electronic transactions documents, wherein the acceptance is non-repudiable. (Abstract; Jevans)

As per claim 2:

The combination of Tomkow and Jevans teaches all the subject matter as discussed above. In addition, Tomkow further teaches the reply from the recipient through the server to the sender is provided on the basis of the unique identification of the message by the server. (page 16, line 1-15)

As per claim 3:

The combination of Tomkow and Jevans teaches all the subject matter as discussed above. In addition, Tomkow further teaches wherein the reply by the recipient through the server provides for an identification of each of a plurality of recipients on the basis of individual identifications related to the unique identification of the message.

(page 16, lines 10-23)

As per claim 4:

The combination of Tomkow and Jevans teaches all the subject matter as discussed above. In addition, Tomkow further teaches wherein the message from the sender to the recipient is provided in a particular format at the server. (page 16, lines 24-28)

As per claims 6 and 16:

The combination of Tomkow and Jevans teaches all the subject matter as discussed above. In addition, Tomkow further teaches wherein the recipient provides a fictional destination address and wherein the destination address is at the server and wherein a database associated with the server stores the identity of the message and the identity and address of the sender and wherein the reply includes an identification of the message and the name and address of the sender and wherein the server parses the message and the name and address of the sender from the fictional destination address and directs the reply to the sender at the sender's address. (page 10, line 5- page 11, line 14; page 31, line 24-page 32, line 6)

As per claim 7:

The combination of Tomkow and Jevans teaches all the subject matter as discussed above. In addition, Tomkow further teaches wherein the reply by the recipient through the server provides for an identification of each of a plurality of recipients on the basis of individual identifications related to the unique identification of the message and wherein the message from the sender to the recipient is provided in a particular format at the server and wherein the reply includes a request from the recipient to receive proof of transmission or delivery of the reply and wherein the server responds to the request in the reply to provide the proof of the transmission or delivery of the reply to the sender and wherein the recipient provides a fictional destination address and wherein the destination address is at the server and wherein a database associated with the server stores the identity of the message and the identity and address of the sender and wherein the reply includes an identification of the message and the name and address of the sender and wherein the server parses the message and the name and address of the sender from the fictional destination address and directs the reply to the sender at the sender's address. (page 10, line 5-page 11, line 14; page 20, line 10-page 21, line 6; page 31, line 24-page 32, line 6)

As per claim 10:

The combination of Tomkow and Jevans teaches all the subject matter as discussed above. In addition, Tomkow teaches wherein the reply by the recipient through the server provides for an identification of each of a plurality of recipients on the basis of individual identifications related to the individual identification of the message.

(page 6, lines 6-25; page 16, lines 16-28)

As per claim 13:

The combination of Tomkow and Jevans teaches all the subject matter as discussed above. In addition, Tomkow further teaches wherein the message is provided with a unique identification by the server and wherein the sender is provided with a unique identification related to the unique identification of the message and wherein the server determines the identification and address of the sender through the identification of the message and wherein the server transmits the reply to the address of the sender. (page 16, lines 1-15; page 20, line 10-page 21, line 6)

As per claim 17:

The combination of Tomkow and Jevans teaches all the subject matter as discussed above. In addition, Tomkow further teaches wherein a delivery receipt is generated from the reply from the recipient to the sender and wherein the delivery receipt is transmitted to the sender and the recipient. (page 22, line 15-page 23, line 30)

As per claim 18:

The combination of Tomkow and Jevans teaches all the subject matter as discussed above. In addition, Tomkow further teaches wherein the message is provided with a particular format and wherein the message is transmitted to the recipient in the particular format. (page 15, line 13-page 16, line 23)

As per claim 19:

The combination of Tomkow and Jevans teaches all the subject matter as discussed above. In addition, Tomkow further teaches a wherein the reply from the

recipient is sent registered from the server to the sender and wherein a delivery receipt is generated for the reply and wherein the delivery receipt is transmitted to the sender and the recipient. (page 15, line 13-page 16, line 23)

As per claim 20:

The combination of Tomkow and Jevans teaches all the subject matter as discussed above. In addition, Tomkow further teaches wherein the server also sends the reply to the recipient to confirm that the recipient has sent the reply to the sender the message is provided with a particular format and wherein the message is transmitted to the recipient in the particular format and wherein the reply from the recipient is sent registered from the server to the sender and wherein a delivery receipt is generated for the reply and wherein the delivery receipt is transmitted to the sender and the recipient. (page 25, lines 4-30)

11. Claims 1, 9, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu et al. (hereinafter Liu) US 6,760,752 in view of in view of Jevans WO 00/25245.

As per claims 1, 9, 11 and 14:

Liu teaches a method of providing a receipt of an email with proof of transmission, receipt and content of a reply to the email that is manually initiated by the recipient, comprising:

receiving a message from a sender at a server displaced from the recipient; (col. 6, line 32-col. 7, line 20; co. 13, line 25-col. 15, line 3; col. 27, line 31-col. 28, line 3; col. 29, line 51-col. 30, line 38)

assigning a unique identification of the message by the server; (col. 6, line 32-col. 7, line 20; co. 13, line 25-col. 15, line 3; col. 27, line 31-col. 28, line 3; col. 29, line 51-col. 30, line 38)

storing the unique identification of the message in a database; (col. 6, line 32-col. 7, line 20; co. 13, line 25-col. 15, line 3; col. 27, line 31-col. 28, line 3; col. 29, line 51-col. 30, line 38)

transmitting the message from the server to the recipient; (col. 6, line 32-col. 7, line 20; co. 13, line 25-col. 15, line 3; col. 27, line 31-col. 28, line 3; col. 29, line 51-col. 30, line 38)

generating a manually initiated reply to the message at the recipient; (col. 6, line 32-col. 7, line 20; co. 13, line 25-col. 15, line 3; col. 27, line 31-col. 28, line 3; col. 29, line 51-col. 30, line 38)

transmitting the manually initiated reply to the sender through the server; (col. 6, line 32-col. 7, line 20; co. 13, line 25-col. 15, line 3; col. 27, line 31-col. 28, line 3; col. 29, line 51-col. 30, line 38)

receiving the manually initiated reply at the server; (col. 6, line 32-col. 7, line 20; co. 13, line 25-col. 15, line 3; col. 27, line 31-col. 28, line 3; col. 29, line 51-col. 30, line 38)

processing the request by the recipient to receive proof of transmission or delivery of the manually initiated reply to the sender; (col. 6, line 32-col. 7, line 20; co. 13, line 25-col. 15, line 3; col. 27, line 31-col. 28, line 3; col. 29, line 51-col. 30, line 38)

transmitting the manually initiated reply by the recipient to the sender in a manner wherein the server receives an indication that the reply is transmitted or delivered to the sender; (col. 6, line 32-col. 7, line 20; co. 13, line 25-col. 15, line 3; col. 27, line 31-col. 28, line 3; col. 29, line 51-col. 30, line 38) and,

transmitting the indication that the reply is transmitted or delivered to the sender to the recipient. (col. 6, line 32-col. 7, line 20; co. 13, line 25-col. 15, line 3; col. 27, line 31-col. 28, line 3; col. 29, line 51-col. 30, line 38)

Liu does not explicitly disclose a manually initiated reply including a request from the recipient to receive proof of transmission or delivery of the manually initiated reply to the sender. Jevans in analogous art, however, discloses a manually initiated reply including a request from the recipient to receive proof of transmission or delivery of the manually initiated reply to the sender. (page 27, line 8-page 28, line 29) Therefore it would have been obvious to one ordinary skill in the art at the time the invention was made to modify the method disclosed by Liu with Jevans in order conduct and audit electronic transactions that allows users to accept or reject received electronic transactions documents, wherein the acceptance is non-repudiable. (Abstract; Jevans)

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEWAYE GELAGAY whose telephone number is (571)272-4219. The examiner can normally be reached on 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. G./
Examiner, Art Unit 2437

/Emmanuel L. Moise/
Supervisory Patent Examiner, Art Unit 2437